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EXAMINER

PRANGE, SHARON M

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANTONIO PIERI

Appeal 2015-000417
Application 13/063,974
Technology Center 3700

Before MICHELLE R. OSINSKI, JEREMY M. PLENZLER, and
PAUL J. KORNICZKY, *Administrative Patent Judges*.

KORNICZKY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant, Antonio Pieri,¹ appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 11–18 and 20–23.² We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellant identifies Alesia Innovation S.r.l. as the real party in interest. Br. 1.

² Claims 1–10 and 19 are cancelled. *Id.*

THE CLAIMED SUBJECT MATTER

The claims are directed to “aerated shoes, i.e.[,] those provided with means which permit atmospheric air to enter, naturally in a limited manner, inside the shoe, so [as] to give a feeling of comfort to the user’s foot.” Spec. 1:2–5. Claim 11, the only independent claim, is reproduced below:

11. A shoe comprising:

a lower sole (5) and an upper sole (3) joined together along an entirety of their respective perimeters by a border (10) bearing fixed slits (12) that are distributed around an entirety of said border (10),

wherein said lower sole (5), said border (10) and said upper sole (3) form an inner chamber or hollow space for the circulation of atmospheric air that has entered from the fixed slits (12), and wherein the lower sole (5) lacks holes or micro-holes, while the upper sole (3) has holes or micro-holes (4) adapted to allow the air coming from said hollow space to pass through;

an air flow regulator (13, 14, 15, 16, 17, 18, 19), manually or directly operable by the user’s finger or with a special tool, and comprising a movable part (13) bearing a plurality of movable slits (15) that are respectively superimposable over said fixed slits (12) so as to ensure an adjustable flow rate of the atmospheric air towards said hollow space; and

a plurality of elements (7), arranged in said hollow space between the lower surface of the upper sole (3) and the upper surface of the lower sole (5), said elements (7) being made of a material provided with a certain degree of elasticity, so as to ensure a suspension and natural cyclic suction and expulsion of the atmospheric air during walking,

wherein the air freely circulates in the hollow space, between and/or through said elements (7), since said elements (7) have interstices which separate them, or openings made thereon, and

wherein the air flow regulator (13, 14, 15, 16, 17, 18, 19) comprises a flexible, closed semi-rigid belt (13) constituting said movable part (13), which laterally extends around the entirety of said border and is slidable within a perimeter groove (11) that

extends around the entirety of said border (10), and has said movable slits (15).

REFERENCES

In rejecting the claims on appeal, the Examiner relied upon the following prior art:

Cho	US 4,837,948	June 13, 1989
Chil	US 6,438,872 B1	Aug. 27, 2002
Moretti	US 6,655,048 B2	Dec. 2, 2003

REJECTIONS

The Examiner made the following rejections:

1. Claims 11, 12, 14–18, 21, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Moretti and Cho.
2. Claims 13, 20, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Moretti, Cho, and Chil.

Appellant seeks our review of these rejections.

ANALYSIS

The Rejection of Claims 11, 12, 14–18, 21, and 22 As Unpatentable Over Moretti and Cho

Appellant argues claims 11, 12, 14–18, 21, and 22 as a group. Br. 4–8. We select claim 11 as the representative claim, and claims 12, 14–18, 21, and 22 stand or fall with claim 11. 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner finds that Moretti discloses all of the limitations of claim 11 except for an air flow regulator that includes “a movable part having a plurality of movable slits.” Final Act. 3–4. The Examiner also determined that it would be obvious to provide

an air flow regulator, as taught by Cho, to the border of [Moretti] as this would be a simple substitution of one type of air flow regulator for another, with the predictable result of allowing for adjustable air flow within the shoe, depending on specific conditions and/or needs of the user, as well as allowing the slits to be closed completely to block out unwanted elements.

Final Act. 4.

In response, Appellant presents several arguments contending that the rejection is incorrect. First, Appellant argues that a skilled artisan would “not be motivated to replace the [Moretti] waterproof membrane 19 with the adjustable openings in CHO because the MORETTI shoe would no longer work as intended by MORETTI.” Br. 5. The Examiner correctly finds that “the openings of Cho can be closed to provide a waterproof shoe (column 2, lines 50-55; column 4, lines 40-45), and therefore the Moretti shoe would still work as intended (providing a waterproof shoe).” Ans. 5. Thus, Appellant does not identify error by the Examiner.

Second, Appellant argues that Moretti does not disclose an “air flow regulator” because membrane 19 and protective element 20

only allow the passage of a certain amount of air per unit time during walking or running, which amount cannot be regulated at all and is determined (i.e.,] is fixed beforehand) by the membrane microstructure. This microstructure (e.g.,] Gore-Tex®) must stop the water from penetrating inside the shoe and must be breathable at the same time. Since it must stop the water it cannot have larger apertures. Indeed, since the membrane 19 extends around the shoe, there may in certain cases be insufficient air exchange between the inside and outside of the shoe.

Br. 5. Appellant does not offer a definition of an “air flow regulator.”

Claim 11 states that an air flow regulator and its movable slits “ensure an

adjustable flow rate of the atmospheric air towards said hollow space.” In response to Appellant’s argument, the Examiner asserts that

the membrane 19 and protective element 20 only allow the passage of a certain amount of air per unit time, therefore acting to control or maintain the rate at which air flows through the sole. A regulator does not need to change the rate at which the air flows, it merely needs to control or maintain that rate.

Ans. 5. The Examiner correctly finds that Moretti’s membrane acts as an air flow regulator and that both Moretti’s and Cho’s air flow regulators control or maintain the air flow towards the recited hollow space, and Cho further provides an adjustable air flow regulator with movable slits. Final Act. 4;

Ans. 6. Appellant does not identify Examiner error.

Third, Appellant argues that Cho does not disclose a “pumping effect,” and Moretti does not disclose an air flow regulator that is “adjustable.” Br. 5–7. However, the Examiner finds that Moretti, not Cho, discloses “natural cyclic suction and expulsion of the atmospheric air during walking. The air freely circulates in the hollow space, between and/or through the elements, since the elements have openings.” Final Act. 3–4.

The Examiner also finds that Cho, not Moretti, discloses an air flow regulator that has movable slits and is, therefore, adjustable. Final Act. 4;

Ans. 5–6. Appellant does not address the rejection as articulated by the Examiner and, thus, does not show Examiner error.

Fourth, Appellant argues that “the Examiner provides ‘ex post facto’ [i.e., hindsight] analysis of the present invention and of the prior art.” Br. 7. However, as discussed above, the Examiner’s findings regarding the air flow regulator are supported by explicit teachings in Moretti and Cho. Appellant does not identify any knowledge relied upon by the Examiner that was

gleaned only from Appellant's disclosure and that was not otherwise within the level of ordinary skill in the art at the time of the invention, thereby obviating Appellant's assertion of hindsight. *See In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971). Thus, Appellant does not apprise us of error.

For the reasons above, the Examiner's rejection of claim 11 is sustained. Claims 12, 14–18, 21, and 22 fall with claim 11.

*The Rejection of Claims 13, 20, and 23
As Unpatentable Over Moretti, Cho, and Chil*

Appellant argues claims 13, 20, and 23 as a group. Br. 8–9. We select claim 13 as representative. Claims 20 and 23 stand or fall with claim 13. 37 C.F.R. § 41.37(c)(1)(iv). Claim 13 depends from claim 11 and further recites that “said air flow regulator . . . comprises a locking means . . . which prevents accidental movements thereof.” The Examiner finds that Chil teaches this additional feature and, based on that teaching, proposes further modifying the shoe of Moretti to include a “locking means.” Final Act. 5. The Examiner reasons that “[i]t would have been obvious . . . to have provided a locking means . . . to the sliding parts of the air flow regulator of the combination of Moretti and Cho in order to prevent unwanted movement of the sliding parts.” *Id.*

Appellant does not dispute that Chil teaches the structure of the “locking means” recited in the claim and, in fact, acknowledges that “[t]he locking mechanism in CHIL (for shoe size adjustment) is generally similar” to the recited “locking means.” Br. 8. Appellant, however, “believes it would not have been obvious to one of ordinary skill in the art to apply this

locking mechanism to claim 13 in which the locking mechanism is used for a different purpose, i.e., for regulating an air flow rate.” *Id.* This does not apprise us of Examiner error because it does not address the combination or rationale proposed by the Examiner. That the locking mechanism of Chil is used with sliding parts in a different part of a shoe does not explain in any manner, let alone persuasively, why one skilled in the art would not have found it obvious to use a locking means in connection with sliding parts of an air flow regulator as proposed by the Examiner. Appellant’s further contention that “[t]here is no indication in the references that a locking mechanism for shoe size would also work for air regulation as claimed” is also unpersuasive. *Id.* We do not read the Examiner’s rejection as requiring that the exact locking mechanism from Chil be bodily incorporated into the modified shoe of Moretti. *See* Final Act. 5 (“It would have been obvious . . . to have provided *a* locking means.”) (emphasis added). The test for obviousness is not “whether the references could be physically combined but whether the claimed inventions are rendered obvious by the teachings of the prior art as a whole.” *In re Etter*, 756 F.2d 852, 859 (Fed. Cir. 1985) (en banc); *see also In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (stating “[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference”).

Appellant’s discussion of the Advisory Action provides no further indication of Examiner error. *See* Br. 8–9 (simply summarizing the Advisory Action and concluding that “CHIL . . . does not disclose or suggest a locking mechanism for an air flow regulator.”).

Accordingly, we are not apprised of Examiner error in the rejection of claims 13, 20, and 23.

DECISION

For the above reasons, the Examiner's rejections of claims 11–18 and 20–23 are AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED